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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/466,994 12/10/99 AKESON

M 06510/118US1

HM12/1029

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EXAMINER

CHIN, C	ART UNIT	PAPER NUMBER
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1641
DATE MAILED:


10/29/01

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No. 09/466,994	Applicant(s) Akeson	
Examiner Chris Chin	Art Unit 1641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 13, 2001
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above, claim(s) 20-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 25-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-29 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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DETAILED ACTION

Election/Restriction

1. This application contains claims 20-24 drawn to an invention nonelected with traverse in Paper No. 9. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 U.S.C. § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-6, 8-14, 16-18, and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Lizardi (U.S. Patent 5,854,033) for the reasons of record in paper #10.

In response to this rejection, Applicants argue that Lizardi does not teach that the disclosed DNA tag is a block copolymer of known composition, comprised of a plurality of blocks, as described in claim 1 and thus does not anticipate the claimed invention.

Applicant's arguments have been considered but are not convincing. Claim 1 requires a block copolymer of a plurality of blocks selected from 2 or more different blocks and the block copolymer is charged. In the DNA tag of Lizardi, groups of three amino acids together form the DNA tag. Each group of three amino acids is considered a block and the blocks together form a

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block copolymer. Each of these blocks are different and together form a block copolymer to meet the limitations of claim 1. Also, the amino acids that form the DNA tag of Lizardi are all known to carry a charged functional group(s).

4. Claims 1-6, 8-14, 16-18, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Oku et al (EP 0698792) for the reasons of record in paper #10.

Applicant's arguments to this rejection are the same as those applied to the Lizardi reference and have thus been addressed since Oku et al discloses a DNA tag similar to that disclosed in Lizardi.

5. Claims 1-6, 8-14, 16-18, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Fields et al (WO 94/26932) for the reasons of record in paper #10.

Applicant's arguments to this rejection are the same as those applied to the Lizardi reference and have thus been addressed since Fields et al discloses a DNA tag similar to that disclosed in Lizardi.

Claim Rejections - 35 U.S.C. § 103

6. Claims 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lizardi, Oku et al, or Fields et al for the reasons of record in paper #10.

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7. Claims 7, 15, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lizardi, Oku et al, or Fields et al in view of Rothschild et al (U.S. Patent 5,986,076) for the reasons of record in paper #10.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

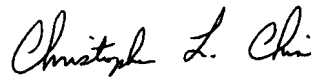
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chris Chin whose telephone number is (703) 308-3991. The examiner can normally be reached on Monday-Thursday from 9:30 am to 7:00 pm. The examiner can also be reached on alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le, can be reached on (703) 305-3399. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

cchin/cc
October 26, 2001



CHRISTOPHER L. CHIN
PRIMARY EXAMINER
GROUP ~~1800~~ 1641